



UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/326,691 06/07/99 MATSUO

K Q54675

EXAMINER

MULCAHY, P

ART. UNIT	PAPER NUMBER
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1713

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DATE MAILED:

09/22/00

IM22/0922
SUGHRUE MION ZINN MACPEAK & SEAS PLLC
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WASHINGTON DC 20037-3202

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

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Office Action Summary

Application No.

09/326,691

Applicant(s)

MATSUO ET AL.

Examiner

Peter D. Mulcahy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☒ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3&4.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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Claims 1 and 9 are rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for rubber compositions having specified ingredients, does not reasonably provide enablement for a rubber composition wherein the limitations are based upon a curve which exhibits a change in dynamic storage modulus. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The claims are directed to a rubber composition which is limited by only property limitations. The Examiner maintains that these are not enabled by the specification given that the patentability is solely dependent upon a property and the claims are not commensurate in scope with the enabling disclosure of the specification because they basically cover any conceivable means for achieving the stated properties. The specification does not provide support for every conceivable means for achieving the property and as such, the specification is not commensurate in scope with the claims. See In re Hyatt 218 USPQ 195.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or

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on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 3 and 19 are rejected under 35 U.S.C. 102(b) or (e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either European Application No. 070143 or J09151279.

Each of these patents shows rubber compositions which incorporate the sodium thiosulfate as instantly claimed. These compositions are used in tire applications and as such, applicants' instantly claimed invention is not novel.

Claims 4-8 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 070143 or J09151279 taken in view of Blok et al.

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As set forth supra, the European and Japanese patent documents set forth applicants' instantly claimed rubber composition having incorporated therein the sulfate compound as instantly claimed. These patents are silent as to the incorporation of a free acrylate compound as claimed herein. The Blok patent clearly shows the desirability of incorporating the acrylate compounds as instantly claimed into tire applications. See specifically column 2 lines 23+. The Examiner maintains that it would be prima facie obvious to incorporate these compounds into the compounds of the prior art since one of ordinary skill in the art would have a reasonable expectation of success.

Claims 9-17 and 20 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Blok et al.

This patent shows rubber compositions which appear to be the same as those instantly claimed having incorporated therein the instantly claimed acrylate compounds. See column 2 lines 23+. In view of this disclosure, applicants' claims are rendered prima facie obvious.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy, whose telephone number is (703) 308-2449. The examiner can normally be reached on Tuesday through Friday from 7:30 A.M. to 6:00 P.M.

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The fax telephone number for this group is (703) 305-3599.

Any inquiry of general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2351.

P. Mulcahy:cdc
September 20, 2000



PETER D. MULCAHY
PRIMARY EXAMINER
GROUP 1500